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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 52

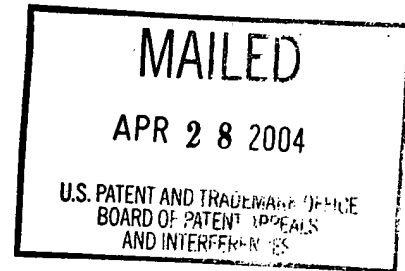
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODNEY L. DOCKERY and CALEB J. PIRTLE

Appeal No. 2003-2005
Application No. 08/813,852

HEARD: April 14, 2004



Before JERRY SMITH, FLEMING, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

ORDER

This is an Order under 37 CFR 1.196(d) in this application on appeal from the examiner's final rejection of claims 18-23 and 25. Claims 1, 4, 10, 17, and 26-28 stand withdrawn from consideration as non-elected claims.

BACKGROUND

Appellants' invention relates to a system and method for promoting stores and products. An understanding of the invention can be derived from a reading of exemplary claim 18, which is reproduced below.

18. A magazine for use in promoting the purchase of specific products, said magazine comprising:

a plurality of general interest articles dispersed throughout the magazine;

at least one of said articles making reference to an identified product, said at least one of said articles including within its confines specific brand information pertaining to said identified product; and

a coupon keyed to said at least one of said articles containing said brand specific information.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Shedd	2,215,163	Sep. 17, 1940
Bullard, Jr.	4,968,061	Nov. 06, 1990
Lamphere et al.	5,127,674	Jul. 07, 1992

Claims 18, 22, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shedd in view of Bullard, Jr. Claims 19-21, and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shedd in view of Bullard, Jr. in view of Lamphere.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 41, mailed Oct. 21, 2002) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 40, filed Aug. 22, 2002) and reply brief (Paper No. 43, filed Dec. 23, 2002) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the preliminary determination which follows.

From our review of the prosecution history, we note that paragraph 5 of the Declaration (Paper No. 36) filed on Mar. 28, 2002, by Caleb J. Pirtle evidencing commercial success states that:

[p]rior to October of 1997, Dockery House offered conventional promotional programs in which conventional promotional magazines which did not include the Dockery House invention would contain general interest articles, possibly recipes which may have included the brand-name of a product to be promoted, and cents-off coupons for some of the products to be promoted. However, as was the case with all previous promotional magazines of which I am aware, these conventional promotional magazines did not include coupons keyed to articles containing brand specific products.

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At the oral hearing appellants' representative was asked if there was additional prior art that appellants may have knowledge concerning these conventional promotional magazines which would "contain general interest articles, possibly recipes which may have included the brand-name of a product to be promoted, and cents-off coupons for some of the products to be promoted." Appellants' representative was unsure of these prior promotional magazines and would look at the prior art submission to see if there were disclosures with respect to support for this statement.

37 CFR § 1.196(d) states:

(d) The Board of Patent Appeals and Interferences may require appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such a requirement.

Pursuant to the provisions of 37 CFR 1.196(d), appellants are given a one month period to submit any prior art submission concerning the admitted prior art programs with conventional promotional magazines that contained "general interest articles, possibly recipes which may have included the brand-name of a product to be promoted, and cents-off coupons for some of the products to be promoted" or to further explain the statement by Mr. Pirtle. After the submission or explanation by appellants, the Board will consider the status of the appeal and application and either remand the application to the examiner to consider the prior art submission or render a decision on the merits at that time.

CONCLUSION

To summarize, we have made a requirement of appellants to submit prior art corresponding to the statement in the declaration or to provide further explanation of the statement by Mr. Pirtle.

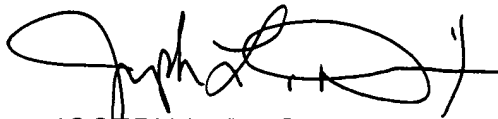
No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).



JERRY SMITH
Administrative Patent Judge



MICHAEL R. FLEMING
Administrative Patent Judge



JOSEPH L. DIXON
Administrative Patent Judge

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